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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,389	01/08/2001	Frank Addante	41411/DJS/L380	6110
23838	7590	12/23/2004	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			MYHRE, JAMES W	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 12/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/757,389

Applicant(s)

ADDANTE, FRANK

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Request for Reconsideration***

1. The Request for Reconsideration filed on October 12, 2004 has been considered but is ineffective to overcome the Reilly et al (5,740,549) and Ballard (6,182,050) references. The response did not amend, cancel, or add any claims. Thus, the currently pending claims considered below remain Claims 1-24.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 9-14, and 16-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Reilly et al (5,740,549).

Claims 1 and 12: Reilly discloses a system for presenting targeted advertisements (creatives) to a user computer that is requesting content pages, comprising:

- a. a creative selection server (Data Server, Item 274, Figure 11),
- b. a content server (Application Server, Item 272, Figure 11); and
- c. a direct connect server (Information Server, Item 104, Figure 11),

connected to the content server, which receives targeting criteria from the content

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server or the user computer, requests an advertisement based on the targeting criteria, and receives identification of one or more advertisements which match the selection criteria (col 4, line 66 – col 5, line 7), which are displayed on a content page which has a space for one or more embedded creatives (Figure 10).

Claims 2 and 13: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 12 above and further discloses that the advertisement is selected as a function of a stored profile (col 7, line 45 – col 8, line 18).

Claims 3 and 16: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of the IP address (identification) of the user computer (col 7, line 45 – col 8, line 18).

Claims 4 and 17: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of the connection history of the user (col 7, line 45 – col 8, line 18).

Claims 5 and 18: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of the domain name of the user computer (col 7, line 45 – col 8, line 18).

Claims 6 and 19: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of a search term entered by the user computer (col 13, line 61 – col 14, line 11).

Claims 7 and 20: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of the IP address of the content server (col 13, line 61 – col 14, line 11).

Claims 9 and 21: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of the connection history of the user (col 7, line 45 – col 8, line 18).

Claims 10 and 22: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of the domain name of the content server (col 7, line 45 – col 8, line 18).

Claims 11 and 23: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses that the advertisement is selected as a function of a meta tag (link) on the content server (col 7, line 45 – col 8, line 18).

Claims 12 and 24: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, and further discloses a lookup table of category codes used to generate a request for a creative message (col 4, line 66 – col 5, line 7 and col 9, lines 35-61),

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (5,740,549) in view of Ballard (6,182,050)

Claims 8 and 15: Reilly discloses a system for presenting targeted advertisements as in Claims 1 and 13 above, but does not disclose that the advertisement is selected as a function of the IP address of the user computer that does not include enough data to derive the actual IP address (i.e. hides the actual identification of the user). However, Ballard discloses a similar system for presenting targeted advertisements in which “key information such as the end user’s name, address or other private data need not be sent to the advertising service provider” (col 3, lines 11-13) thus, “advertising service provider can protect the identity of computers making requests for advertisements, and thus preserve the end user’s privacy” (col 4, lines 33-35). Therefore, it would have been obvious to one having ordinary skill in the

art at the time the invention was made to preserve the user's privacy in Reilly by not disclosing the user's actual IP address. One would have been motivated to prevent the disclosure of the user's IP address in order to "preserve the user's privacy" as discussed in Ballard.

### ***Response to Arguments***

6. Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive.

a. The Applicant argues that Reilly does not disclose the direct connect server receiving creative selection criteria from the content server because "the label 'information server' merely represents a router 270, application servers 272 and data servers 274" (page 6) and is not "connected to a public network separately from a creative selection server" (page 7). The Examiner notes that while the information server may include a router, it also "includes a central processing unit 110, primary memory 112 (i.e. fast random access memory) and secondary memory 114 (typically disk storage, a user interface 116, an Internet interface 118 for communication with the client computers 102 via the Internet 119, and one or more news wire interfaces 120 for receiving news feeds from information transmission services such as the AP news feed, the DOW news feed and various sports news feeds" (col 4, lines 23-31). Thus, the information server is the server to which the user connects through the Internet., i.e. direct connect server (col 4, lines 8-10). The information server is also connected through a local area network (LAN) to other computers, such as the application servers

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and data servers (col 14, lines 20-29), and is used to select content and advertising based on the selection criteria (categories) received from the user computer and/or the application servers.

b. The Applicant's arguments in reference to the obviousness rejection of Claims 8 and 15 are also non-persuasive for the same reasons as discussed above.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.



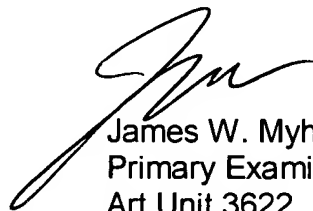
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
December 22, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622